UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,149	09/12/2003	Jason A. Ashton	026224-000130US	6799

20350 7590 11/01/2006

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER	
BODDIE, WILLIAM	

ART UNIT	PAPER NUMBER
2629	

DATE MAILED: 11/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/661,149	ASHTON, JASON A.	
	Examiner	Art Unit	
	William Boddie	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 39-61 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 39-61 is/are rejected.

7)☒ Claim(s) 48,54 and 58 is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 8/25/06.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. In an amendment dated, August 25th, 2006, the Applicant cancelled claims 1-38 and added new claims 39-61. Currently claims 39-61 are pending.

Claim Objections

2. Claim 48 is objected to because of the following informalities: line 15 of the claim ends in a period even though there is an additional limitation on lines 16-17 of the claim. Additionally the limitation citing a second interface appears to be included in the remote control. This is wholly unsupported within the specification, applying tabs and punctuation that makes it clearer that the second interface is not intended to be included in the remote is requested. Appropriate correction is required.

3. Claim 54 is objected to because of the following informalities: line 1 of the claim states, "wherein remote control." This is incorrect grammatically. Appropriate correction is required.

4. Claim 58 is objected to because of the following informalities: the preamble of claim 58 is different from that of claim 57 to which it is dependent. Furthermore there is no specific mention of a "secure transaction system" in claim 57, instead there is a video display system configured for performing a secure transaction. Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 51 recites the limitation "the display" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Specifically it is unclear as to if this claim requires an additional display located within the remote control that works in conjunction with the "video display" recited in claim 48, or if "the display" recited in claim 51 and the "video display" of claim 48 are one in the same.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 39-41, 46, 48, 52-53, and 56-58 are rejected under 35 U.S.C. 102(b) as being anticipated by Erlin (US 5,973,756).

With respect to claim 39, Erlin discloses, a remote control (10 in fig. 4) for controlling a video display system (40-44 in fig .4) comprising:

an exterior surface of the remote control including a data entry portion (14-26 in fig. 1) by which a user of the remote control can control power and volume of the video display system (power switch and volume buttons in fig. 1);

a slot in the exterior surface of the remote control (12 in fig. 2) capable of receiving a card shaped object upon which data is stored (30 in fig. 1);

a sensor (Magnetic card swipe reader 57 in fig. 3) disposed within the exterior surface of the remote control and in proximity to the slot, the sensor being adapted to read data stored upon the card shaped object (col. 3, lines 24-33);

a memory (54 in fig. 3) for storing the data read from the card-shaped object (col. 3, lines 24-33);

a circuit (65, 53 in fig. 3) for encrypting the data received from the card-shaped object (col. 4, lines 38-41); and

an interface (59-60 in fig. 3) coupled to the sensor for providing the encrypted data to the video display system (clear from fig. 4).

With respect to claim 40, Erlin discloses, the remote control of claim 39 (see above) wherein the card shaped object stores information magnetically and the sensor detects the magnetic information (col. 3, lines 24-33).

With respect to claim 41, Erlin discloses, the remote control of claim 40 (see above) wherein the card shaped object comprises a credit card (title).

With respect to claim 46, Erlin discloses, the remote control of claim 41 (see above), wherein the data provided from the sensor to the video display system comprises an account number (Credit Card Account Number in fig. 6D).

With respect to claim 48, Erlin discloses, a video display system (fig. 4) for providing transactional capability from a remote control device, the system comprising:

a video display (42 in fig. 4);

a remote control (10 in fig. 4) configured to control the display (clear from the buttons in fig. 1), the remote control including:

an exterior surface of the remote control including a data entry portion (14-26 in fig. 1) by which a user of the remote control can control power and volume of the video display system (power switch and volume buttons in fig. 1);

a slot in the exterior surface of the remote control (12 in fig. 2) capable of receiving a card shaped object upon which data is stored (30 in fig. 1);

a sensor (Magnetic card swipe reader 57 in fig. 3) disposed within the exterior surface of the remote control and in proximity to the slot, the sensor being adapted to read data stored upon the card shaped object (col. 3, lines 24-33);

a memory (54 in fig. 3) for storing the data read from the card-shaped object (col. 3, lines 24-33);

a circuit (65, 53 in fig. 3) for encrypting the data received from the card-shaped object (col. 4, lines 38-41); and

an interface (59-60 in fig. 3) coupled to the sensor for providing the data from the memory to the video display system (clear from fig. 4),

a second interface configured to transfer the read data to a communications network (note the interface connection with an ATM network in fig. 7; col. 8, lines 3-5).

With respect to claim 52, Erlin discloses, a method of using a remote control for a video display system to capture data from a card shaped object and securely transmit it (fig. 6a-6h) comprising:

providing a remote control (10 in fig. 2) having a slot (12 in fig. 2) therein for receiving the card shaped object (fig. 6a);

placing the card shaped object in the slot (fig. 1; fig. 6b);

detecting data on the card shaped object (col. 3, lines 24-33);

at least temporarily storing the data read from the card shaped object in a memory in the remote control (col. 3, lines 24-33);

using a wireless interface, transferring the data read from the remote control to the video display system (fig. 6c);

transferring the data from the video display system to a third party (card issuer bank in fig. 10); and

authenticating the data transferred from the video display system (the bank verifies the PIN and account number; col. 8, lines 33-40).

With respect to claim 53, Erlin discloses, the method of claim 52 (see above) further including encrypting the detected data before it is transferred to the video display system (col. 4, lines 38-40).

With respect to claim 56, Erlin discloses, the remote control of claim 53 (see above), using the Data Encryption Standard (DES) to encrypt the read data using a DES logic circuit (133 in fig. 7).

Furthermore, the DES inherently requires the generation of a pseudorandom number for use in the encryption of the data.

With respect to claim 57, Erlin discloses, a video display system configured for performing a secure transaction (fig. 4), the video display system comprising:

a remote control (10 in fig. 1) including video control means for controlling functions of the video display system (clear from the buttons on the remote);

the remote control further including slot (12 in fig. 2) means for allowing a card shaped object (30 in fig. 1) having data stored thereon (32 in fig. 1) to be read by the remote control;

sensor means (57, 65 in fig. 3) for reading data from the card shaped object (magnetic card swipe reader) and encrypting the data (DES);

interface means for transferring the data read from the remote control to the video display system (59-60 in fig. 3); and

network means for transferring data read from the video display system to a communications network (note the interface between the set top box and the ATM network; col. 8, lines 3-5).

With respect to claim 58, Erlin discloses, the secure transaction system of claim 57 (see above), further including encryption means for encrypting the read data (65 in fig. 3).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. Claims 42-43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (US 5,973,756) in view of Grefenstette et al. (US 6,498,567).

With respect to claims 42-43, Erlin discloses, the remote control of claim 39 (see above).

Erlin does not expressly disclose, that the card shaped object stores information optically and the sensor detects the optical information, in the form of bar codes.

Grefenstette discloses, a remote control device that comprises a sensor (12 in fig. 2) that detects optical information that has been stored in the form of bar codes (col. 3, lines 29-37; also note col. 4, lines 61-62).

Grefenstette and Erlin are analogous art because they are both from the same field of endeavor namely, remote controls with additional card reader functions.

At the time of the invention it would have been obvious to one of ordinary skill in the art to replace the magnetic stripe technology of Erlin with the optical technology taught by Grefenstette.

The motivation for doing so would have been a lower cost for the implementation of bar code technology over the magnetic stripe technology.

Therefore it would have been obvious to combine Grefenstette and Erlin for the benefit of cost to obtain the invention as specified in claims 42-43.

11. Claims 44, 47 and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (US 5,973,756) in view of Claassen (US 6,069,672).

With respect to claim 44, Erlin discloses, the system of claim 39 (see above).

Erlin does not expressly disclose, wherein the remote control further includes a logic circuit for comparing the encrypted data from the card shaped object with data previously stored in the system.

Claassen discloses, wherein a remote control (50 in fig. 4) further includes a logic circuit (26 in fig. 4) for comparing encrypted data from a card shaped object (40 in fig. 4) with data previously stored in the system(col. 2, lines 18-25).

Erlin and Claassen are analogous art because they are both from the same field of endeavor namely remote controls with additional card reader functions.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the comparison means, taught by Claassen, in the device of Erlin.

The motivation for doing so would have been to determine if said card has been previously used in another device or to tie the card to a specific remote (Claassen; col. 2, lines 23-25).

Therefore it would have been obvious to combine Claassen with Erlin for the benefit of tying a card to a specific remote to obtain the invention as specified in claim 44.

With respect to claim 47, Erlin and Claassen disclose, the remote control of claim 44 (see above).

Erlin further discloses, using the Data Encryption Standard (DES) to encrypt the read data using a DES logic circuit (133 in fig. 7).

Furthermore, the DES inherently requires the generation of a pseudorandom number for use in the encryption of the data.

With respect to claim 49, Erlin discloses, the system of claim 48 (see above).

Erlin does not expressly disclose, wherein the remote control further includes a logic circuit for comparing the encrypted data from the card shaped object with data previously stored in the system.

Claassen discloses, wherein a remote control (50 in fig. 4) further includes a logic circuit (26 in fig. 4) for comparing encrypted data from a card shaped object (40 in fig. 4) with data previously stored in the system(col. 2, lines 18-25).

Erlin and Claassen are analogous art because they are both from the same field of endeavor namely remote controls with additional card reader functions.

At the time of the invention it would have been obvious to one of ordinary skill in the art to include the comparison means, taught by Claassen, in the device of Erlin.

The motivation for doing so would have been to determine if said card has been previously used in another device or to tie the card to a specific remote (Claassen; col. 2, lines 23-25).

Therefore it would have been obvious to combine Claassen with Erlin for the benefit of tying a card to a specific remote to obtain the invention as specified in claim 49.

With respect to claim 50, Erlin and Claassen disclose, the system of claim 49 (see above).

Erlin further discloses, including a network server (card issuer bank in fig. 10) coupled to the second interface and configured to decrypt the data transferred to the communications network (decrypts the PIN PEK3 and verifies the data).

12. Claims 45, 51 and 54-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (US 5,973,756) in view of Croy et al. (US 6,040,829).

With respect to claim 45, Erlin discloses, the remote control of claim 39 (see above) the interface provides data from the sensor to the video display system (col. 3, lines 37-38).

Erlin does not expressly disclose, transmitting identification information about the remote control to the video display system.

Croy discloses, transmitting both remote control identification information (col. 4, lines 43-46) and data from a sensor to a video display system (col. 5, lines 57-66).

Croy and Erlin are analogous art because they are both from the same field of endeavor namely, remote controls with additional card reader functions.

At the time of the invention it would have been obvious to transmit remote control identification information, as taught by Croy, in addition to the sensor data of Erlin.

The motivation for doing so would have been to allow the remote to be uniquely identified allowing for greater security (col. 6, lines 22-32).

Therefore it would have been obvious to combine Croy with Erlin for the benefit of enhanced security to obtain the invention as specified in claim 45.

With respect to claim 51, Erlin discloses, the system of claim 48 (see above).

Erlin does not expressly disclose, wherein the display is contained within the remote control and the display is further configured for use in programming the remote control.

Croy discloses, wherein a display (240 in fig. 3a) is contained within a remote control (200 in fig. 3a) and the display is further configured for use in programming the remote control (fig. 38-43; col. 18, lines 33-49).

At the time of the invention it would have been obvious to one of ordinary skill in the art to include a display in the remote of Erlin, as taught by Croy.

The motivation for doing so would have been to allow the user to continue to view the programming on the television without overlaying a menu on top of the screen. Also the inclusion of a display on the remote to facilitate programming the remote gives the additional advantage of privacy for the user (Croy; col. 2, lines 1-9).

Therefore it would have been obvious to combine Croy with Erlin for the benefit of added privacy and consideration of other television users to obtain the invention as specified in claim 51.

With respect to claim 54, Erlin discloses, the remote control of claim 52 (see above) the interface provides data from the sensor to the video display system (col. 3, lines 37-38).

Erlin does not expressly disclose, transmitting identification information about the remote control to the video display system.

Croy discloses, transmitting both remote control identification information (col. 4, lines 43-46) and data from a sensor to a video display system (col. 5, lines 57-66).

Croy and Erlin are analogous art because they are both from the same field of endeavor namely, remote controls with additional card reader functions.

At the time of the invention it would have been obvious to transmit remote control identification information, as taught by Croy, in addition to the sensor data of Erlin.

The motivation for doing so would have been to allow the remote to be uniquely identified allowing for greater security (col. 6, lines 22-32).

Therefore it would have been obvious to combine Croy with Erlin for the benefit of enhanced security to obtain the invention as specified in claim 54.

With respect to claim 55, Croy and Erlin disclose, the method of claim 54 (see above).

Croy further discloses, wherein the card shaped object comprises a credit card (col. 5, lines 48-50), and further including a step of determining whether the credit card is authorized to perform the secure transactions by using the device identification data (col. 6, lines 38-43; discloses the use of a PIN and the code of the remote device to determine the credit limits granted to the user/remote).

13. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (US 5,973,756) in view of Thompson et al. (US 6,504,580).

With respect to claim 59, Erlin discloses, a video display system comprising,

a video display (42 in fig. 4);

a remote control (10 in fig. 1) configured to control at least power and volume functions of the video display (power switch and volume buttons in fig. 1), the remote control including:

a mechanical data entry portion having a power on/off control and a volume control (14-26 in fig. 1);

a slot (12 in fig. 2) for receiving a credit card (30 in fig. 1);

an electromagnetic sensor positioned to read data from the credit card as the credit card is passed through the slot (57 in fig. 3);

a memory connected to the sensor to store the data read from the credit card (54 in fig. 3; col. 3, lines 24-33);

a first wireless interface configured to transfer the data from the credit card data to the video display system (59-60 in fig. 3);

the video display being configured to display a menu responsive to the data transferred from the credit card (see fig. 6c),

a second interface configured to transfer data stored in the memory to a communications network (note the interface between the set top box and the ATM network, which transfers the account number and the PIN; col. 8, lines 3-5).

Erlin further discloses, transferring a PEK from the video display to the remote control through a first interface for storage in the memory (col. 7, lines 45-49).

Erlin does not expressly disclose, selecting a character from a menu, and subsequently storing that character in the remote's memory.

Thompson discloses, selecting a character from a menu and subsequently storing that character in a remote controller's memory (fig. 8; col. 6, lines 48-65).

Thompson and Erlin are analogous art because they are both from the same field of endeavor namely remote controls with additional purchasing functions.

At the time of the invention it would have been obvious to one of ordinary skill in the art to allow the character selection and storage, as taught by Thompson, in the device of Erlin.

The motivation for doing so would have been to allow the device to transmit a unique identifying number to the purchaser (col. 6, lines 48-53); or as an alternative to input account numbers should the stripe reader not work.

Therefore it would have been obvious to combine Thompson with Erlin for the benefit of a uniquely identifying number as well as a back up account number input method to obtain the invention as specified in claim 59.

14. Claims 60-61 rejected under 35 U.S.C. 103(a) as being unpatentable over Erlin (US 5,973,756) in view of Thompson et al. (US 6,504,580) and further in view of Budow et al. (US 5,661,517).

With respect to claims 60-61, Erlin and Thompson disclose, the video display system of claim 59 (see above).

Neither Erlin nor Thompson expressly disclose, wherein the memory also stores device identification data and user address data.

Budow discloses, wherein a memory (within 4 in fig. 1; col. 6, lines 50-56) also stores device identification data (col. 13, lines 47-49) and user address data (col. 24, lines 60-66).

Budow, Erlin and Thompson are all analogous art because they are from the same field of endeavor namely, video display systems, operated by remote controls with purchasing functionality.

At the time of the invention it would have been obvious to one of ordinary skill in the art to store device identification and user address data, as taught by Budow, in the remote devices of Erlin and Thompson.

The motivation for doing so would have been to personalize each remote device to a specific user, as well as to off point-of-sale services based on intelligent processing of the known, required data (Budow; col. 7, lines 6-20).

Therefore it would have been obvious to combine Budow with Erlin and Thompson for the benefit of personalized remote devices to obtain the invention of claims 60-61.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Will Boddie whose telephone number is (571) 272-0666. The examiner can normally be reached on Monday through Friday, 7:30 - 4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on (571) 272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Wlb
10/13/06

AMR A. AWAD
SUPERVISORY PATENT EXAMINER